

## **REMARKS**

This is a full and timely response to the outstanding final Office Action mailed May 11, 2006. Upon entry of the amendments in this response, claims 134 – 138 remain pending. More specifically, Applicants amend claim 134. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **I. Objections to the Drawings**

The Office Action indicates that the drawings are objected to as failing to comply with 37 CFR 1.83(a) because they do not show every feature of the invention specified in the claims. Applicants respectfully traverse this objection for at least the reason that FIG. 3 illustrates an STT 16 that may include at least one processor 35 that is programmed to enable the STT to, responsive to a presentation specific rental flag, enable a plurality of user selectable rental options. For at least this reason, Applicants respectfully traverse this objection.

Applicants additionally traverse this objection for at least the reason that 37 C.F.R. §1.81 states “[t]he applicant for a patent is required to furnish a drawing of his or her invention where necessary for the understanding of the subject matter sought to be patented” (emphasis added). Applicants respectfully submit that 37 C.F.R. §1.83 must be read in conjunction with 37 C.F.R. §1.81 and that even if the examiner is unable to find this feature in the drawings, Applicants submit that this feature is not needed for understanding of the claimed subject matter. For at least the additional reason that presence of this element in the drawings is not necessary for the understanding of the subject matter sought to be patented, Applicants respectfully traverse this objection.

## **II. Claim Objections**

The Office Action indicates that claim 134 is objected to because the recitations of “the presentation” and “the particular presentation” lack proper antecedence. In an effort to comply with the Office Action’s request, Applicants amend claim 134 by removing the term “particular.” Applicants submit that this amendment places claim 134 in condition for allowance.

## **III. Rejections Under 35 U.S.C. §103**

In order for a claim to be properly rejected under 35 U.S.C. §103, the teachings of the cited art reference must suggest all features of the claimed invention to one of ordinary skill in the art. *See, e.g., In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). Further, “[t]he PTO has the burden under section 103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

### **A. Claim 134 is Allowable Over *White* in view of *Neel* in view of *Bee* and further in view of *Matthews***

The Office Action indicates that claim 134 stands rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,628,302 (“*White*”) in view of U.S. Patent Number 5,838,314 (“*Neel*”) in view of a Dixie Reid Bee (staff writer) article entitled: “Coming Attractions Before They Hit the Big Screen, Most Films Begin Life as a Trailer; [Metro Final

Edition], hereinafter ("*Bee*") and further in view of U.S. Patent Number 5,914,746 ("*Matthews*").

Applicants respectfully traverse this rejection for at least the reason that *White* in view of *Neel*, in view of *Bee*, and further in view of *Matthews* fails to disclose, teach, or suggest all of the elements of claim 134. More specifically, claim 134 recites:

A television set-top terminal ("STT") coupled to a server via a bi-directional communication network, said STT comprising:

memory having at least one program code stored therein;

at least one processor that is programmed by the program code to enable the STT to:

receive via tuner in the STT media guide data corresponding to a media guide for on-demand rentable video presentations;

provide a media guide presentation to a user via a television signal, the media guide presentation comprising at least a portion of the media guide data corresponding to a plurality of on-demand rentable video presentations;

responsive to presentation specific rent flags received from the server, enable a plurality of user-selectable rental options specific to each one of the plurality of on-demand rentable video presentations in the media guide presentation;

***configure a first rental option*** in the plurality of user-selectable rental options to provide a user-selectable option to view a user-selected on-demand rentable video presentation ***without presentation promotional advertising*** that is otherwise ***shown during presentation*** of the user-selected on-demand rentable video presentation;

***configure a second rental option*** in the plurality of user-selectable rental options to provide a user-selectable option to view a user-selected on-demand rentable video presentation ***without preceding movie trailers*** that are otherwise ***shown immediately prior to presentation*** of the user-selected on-demand rentable video presentation;

receive a first user input corresponding to a selection of one of the plurality of on-demand rentable video presentations in the media guide presentation;

provide the first rental option and the second rental option to the user responsive to the first user input;

receive a second user input responsive to providing the first rental option and the second rental option;

provide the one of the plurality of rentable video presentations to the user without presentation promotional advertising during the presentation and without preceding movie trailers responsive to

the second user input corresponding to the selection of the first rental option and the second rental option; and

suspend the provision of the rentable video presentation and provide the user with suspension promotional advertising responsive to third user input, wherein the suspension promotional advertising provided during suspension of the presentation is configured by the server and is independent of the particular presentation and independent of the first rental option and the second rental option. (*emphasis added*)

Applicants respectfully submit that claim 134 is allowable over the cited art for at least the reason that the cited art fails to disclose, teach, or suggest an STT configured to “*configure a first rental option* in the plurality of user-selectable rental options to provide a user-selectable option to view a user-selected on-demand rentable video presentation *without presentation promotional advertising* that is otherwise *shown during presentation* of the user-selected on-demand rentable video presentation... [and] *configure a second rental option* in the plurality of user-selectable rental options to provide a user-selectable option to view a user-selected on-demand rentable video presentation *without preceding movie trailers* that are otherwise *shown immediately prior to presentation* of the user-selected on-demand rentable video presentation” as recited in claim 134.

More specifically, *Neel* appears to disclose a “graphics screen [that] asks the user if he or she wants to be billed for the movie or, instead, if they want to watch one or more advertisements and have the advertisers pay for the movie” (col. 17, line 46). However, nowhere in *Neel*, nor in any of the other cited reference is there mention of “*configur[ing] a first rental option... [and] configur[ing] a second rental option... [for providing] a user-selectable option to view a user-selected on-demand rentable video presentation without preceding movie trailers* that are otherwise *shown immediately prior to presentation* of the user-selected on-demand rentable video presentation” as recited in claim 134. The Office Action asserts that the “specification [of

the present application] does not clearly support or disclose that the claimed ‘options’ are necessarily separately/independently selectable” (OA p. 8, line 8). However, Applicants respectfully disagree with this analysis. More specifically, Applicants submit that the specification includes a plurality of non-limiting examples. As one of ordinary skill in the art will understand, one or more of these non-limiting examples may be included in one or more different embodiments. One of ordinary skill in the art will also understand that, depending on the particular embodiment, one or more of these options (non-limiting examples) may be “separately/independently” selectable. As such, Applicants submit that *Neer* fails to suggest a “second rental option.” Similarly, the inclusion of *Bee*, which appears to simply indicate that a movie may be associated with a trailer, does not render claim 134 obvious for at least the reason that there is no suggestion of a “*a second rental option* in the plurality of user-selectable rental options to provide a user-selectable option to view a user-selected on-demand rentable video presentation *without preceding movie trailers* that are otherwise *shown immediately prior to presentation* of the user-selected on-demand rentable video presentation” as recited in claim 134. For at least these reasons, claim 134 is allowable over the cited art.

**B. Claim 135 is Allowable Over *White* in view of *Neel*, in view of *Bee*, and further in view of *Matthews***

The Office Action indicates that claim 135 stands rejected under 35 U.S.C. 103(a) as being unpatentable over *White* in view of *Neel*, in view of *Bee*, and further in view of *Matthews*. Applicants respectfully traverse this rejection for at least the reason that *White* in view of *Neel*, in view of *Bee*, and further in view of *Matthews* fails to disclose, teach, or suggest all of the elements of claim 135. More specifically, dependent claim 135 is believed to be allowable for at

least the reason that this claim depends from allowable independent claim 134. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

**C. Claims 136 – 138 are Allowable Over *White* in view of *Neel* in view of *Bee* in view of *Matthews* and further in view of *Kikinis***

The Office Action indicates that claims 136 – 138 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,628,302 (“*White*”) in view of U.S. Patent Number 5,838,314 (“*Neel*”) in view of a Dixie Reid Bee (staff writer) article entitled: “Coming Attractions Before They Hit the Big Screen, Most Films Begin Life as a Trailer; [Metro Final Edition], hereinafter (“*Bee*”) further in view of U.S. Patent Number 5,914,746 (“*Matthews*”) and further in view of U.S. Patent No. 5,929,849 (“*Kikinis*”). Applicants respectfully traverse this rejection for at least the reason that *White* in view of *Neel*, in view of *Bee*, further in view of *Matthews*, and further in view of *Kikinis* fails to disclose, teach, or suggest all of the elements of claims 136 – 138. More specifically, dependent claims 136 – 138 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 134. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

## CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Further, any and all findings of well known art and official notice, or statements interpreted similarly, should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. Additionally, while in previous correspondences Applicants traversed findings of Official Notice, inherency, and allegedly well known subject matter, those traversals are reiterated herein for at least the specific and particular reasons previously indicated.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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